

REMARKS

Claims 1, 5-7 and 9 are all the claims pending in the application. By this Amendment, Applicant editorially amends claim 9. The amendment to claim 9 is made for reasons of precision of language and consistency, and does not narrow the literal scope of the claim and thus do not implicate an estoppel in the application of the doctrine of equivalents. The amendments to claim 9 is not made for reasons of patentability. In addition, by this Amendment, Applicant rewrites claim 5 in its independent form.

Preliminary Matters

As preliminary matters, the Examiner's acknowledgement of the claim to foreign priority, and confirmation that the certified copy of the priority document has been received for Application No. 09/794,959 is gratefully noted, and also the Examiner's initialing of the references listed on Form PTO/SB/08 A & B submitted with the Information Disclosure Statement filed on February 19, 2004.

The Examiner, however, has not indicated receipt or consideration of the references listed on form PTO/SB/08 A & B submitted with the Information Disclosure Statement filed on August 5, 2003. Therefore, the Examiner is respectfully requested to acknowledge receipt of the Information Disclosure Statement filed on August 5, 2003 and to initial and return a copy of the Form PTO/SB/08 A & B.

In addition, the Examiner provisionally rejected claims 1, 6, and 9 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2 and

4 (or claim 7) respectively of U.S. Patent No. 6,628,236 B2. Applicant files herewith a terminal disclaimer, thereby overcoming the rejection.

Objections to the Specification and the Drawings

The Examiner objected to the specification and the drawings for failing to describe an “antenna tip” and “a position with the tip not protruding above said cover member.” For the sake of expediting prosecution of the present Application, Applicant amends Fig. 4, see Replacement Sheet, to label the antenna tip with a reference 25a. In addition, Applicant amends the Specification to reference the antenna tip 25a. These amendments to the drawings and the specification are respectfully submitted to overcome the Examiner’s objections. No new matter is being added.

Claim Rejections

The Examiner rejected claims 1 and 9 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,295,462 B1 to Kudoh (hereinafter “Kudoh”), claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Kudoh view of U.S. Patent No. 5,684,672 to Karidis et al. (hereinafter “Karidis”), and claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Kudoh in view of US Patent Publication No. 2002/0013160 to Harano (hereinafter “Harano”). The Examiner’s careful reconsideration is submitted to be appropriate in view of the comments, which follow.

Of the rejected claims, only claims 1 and 9 are independent. Independent claim 1 recites a unique combination of features including “a computer having a cover member with a computer display”. The Examiner alleges that claim 1 is anticipated by Kudoh and that Kudoh’s cover is

equivalent to the cover as set forth in claim 1. This ground of rejection is respectfully submitted to be incorrect as a technical matter.

To be an “anticipation” rejection under 35 U.S.C. § 102, the reference must teach *every element and recitation of the Applicant’s claims*. Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. Thus, the reference must clearly and unequivocally disclose every element and recitation of the claimed invention.

Kudoh teaches a portable radio information terminal. In particular, Kudoh teaches separating the information processing section located in the main body, from the radio communication section located on the cover, so as to prevent noise from the information processing section and other main body components. Kudoh’s main body comprises of an open/close detector 11, control section 4A, a battery 3, display section 5 and input section 6 (see Fig. 4, col. 5, lines 28 to 54). In Kudoh, shield 8 is inserted between the main body 1 and the cover 2 to attenuate noise propagated from the main body 1 (col. 4, lines 51 to 55). In the cover 2, Kudoh has two antennas 17 and 9 (see Fig. 2; col. 5, lines 1 to 14). When the portable terminal is in a closed position, only the inverted antenna 9 receives radio signals, whereas when the portable terminal is open both antennas receive radio signals. In the open position, whip antenna 7 is protected from noise by the shield 8 (see col. 4, line 51 to col. 5, line 14).

Kudoh, however, clearly fails to anticipate claim 1 at least because *its display is located on the main body and not on the cover as required by claim 1*. For example, Kudoh seems to recognize the danger of placing computer components such as a display next to the antennas,

especially next to an inverted F antenna. Therefore, Kudoh placed antennas separately in a cover, away from all other elements. Kudoh is also concerned with arrangement of features with respect to the antennas, as well as with respect to the size of the structure. In short, Kudoh does not teach or suggest positioning the display on a cover for better visibility.

Therefore, “a computer having a cover member with a computer display” as set forth in claim 1 is not suggested or taught by Kudoh. For at least these reasons independent claim 1 is patentably distinguishable from Kudoh and it is appropriate and necessary for the Examiner thus to withdraw this rejection of independent claim 1.

Applicant next addresses this rejection with respect to claim 9. Claim 9 recites: “a cover member with a display for displaying an image.” For at least substantially similar reasons as those set forth with respect to claim 1, independent claim 9 is patentably distinguishable from Kudoh. It is appropriate and necessary for the Examiner thus to withdraw this rejection of independent claim 9.

Next, the rejection of claim 6, which depends on claim 1, is addressed. It was already demonstrated that Kudoh does not meet all the requirements of independent claim 1. Karidis is relied upon only for its teaching of a retractable antenna. In addition, there is no motivation to combine the two references in a manner suggested by the Examiner.

Karadis teaches replacing the antenna for the adopter card, which is usually positioned on a side with an antenna extending from the cover when in use. In addition, Karadis teaches that the antenna is retractable for convenience and ruggedness. Karadis, however, teaches *replacing* a side antenna with a whip antenna. Kudoh, on the other hand, is concerned with the danger of

placing computer components such as a display next to the antennas, especially next to an inverted F antenna. Therefore, Kudoh placed antennas separately in a cover, away from all other elements. Therefore, one of ordinary skill in the art would not have been motivated to move Karadis's display to the Kudoh's cover.

In short, together, the combined teachings of these references would not have (and could not have) led the artisan of ordinary skill to have achieved the subject matter of claim 1. Since claim 6 is dependent upon claim 1, it may be patentable at least by virtue of its dependency.

Finally, the rejection of claim 7, which depends on claim 1 is addressed. Claim 7 is rejected as being unpatentable over Kudoh in view of Harano. It was already demonstrated that Kudoh does not meet all the requirements of independent claim 1. Harano is relied upon only for its teaching of having an antenna in the main body. Harano, however, teaches an antenna in the main body so that a portable pen can be inserted therein. That is, there is no motivation to combine the two references in a manner suggested by the Examiner.

In Kudoh, the antennas are placed in the cover to be away from the display and the main body for better noise attenuation. Harano places the antenna on the main body to provide a pen storing section in the antenna section, thereby conserving space. Kudoh does not teach or suggest a portable pen based operation radio; therefore, there is no motivation for Kudoh to move the antenna to the main body to reduce the noise attenuation or increase the size of the portable terminal. In addition, Kudoh would not have been motivated to move Harano's display to the cover because this would have worsened noise attenuation, which is the main focus of Kudoh's teachings.

In short, together, the combined teachings of these references would not have (and could not have) led the artisan of ordinary skill to have achieved the subject matter of claim 1. Since claim 7 depends from claim 1, it may be patentable at least by virtue of its dependency.

Allowable Subject Matter

The Examiner's indication that claim 5 contains allowable subject matter is gratefully noted. Applicant rewrites claim 5 into its independent form including all the limitations of the base claim. Therefore, it is appropriate and necessary for the Examiner to allow claim 5.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below. The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Kelly G. Hyndman
Registration No. 39,234

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: July 30, 2004